

REMARKS

Claims 1-10 and 20-23 have been rejected under 35 U.S.C. §103(a) as unpatentable over the patent to De Lapa et al. (U.S. 5,353,218 and hereinafter also referred to as De Lapa) in view of the patent to Day et al. (U.S. 5,857,175 and hereinafter also referred to as Day). Claims 11-14 and 16-19 were rejected under a 35 U.S.C. §103(a) as unpatentable over the patent to Oyama et al. (U.S. 5,496,175 and hereinafter also referred to as Oyama) in view of the De Lapa patent.

Independent Claims 1, 11, 20 and 22 have been amended to patentably differentiate the present invention from such prior art. Additionally, dependent Claims 8 and 23 have been canceled, while new dependent Claims 24-28 have been included. Reconsideration of the rejection of Claims 1-7, 9-14 and 16-22, together with consideration of new Claims 24-28, is respectfully requested.

The present invention is directed to obtaining information from consumers to obtain marketing information, as well as other information deemed useful. In one embodiment, such information is obtained from a number of sources. In another embodiment, an interactive apparatus is a key source of information gathering and obtains a desired or determined one or both of specific product/service information and/or general information including opinions associated with one or more topics.


The prior art, particularly the De Lapa, Day and Oyama patents are deficient in accomplishing the functions and meeting the flexibilities/options for obtaining information required by the amended claims. The De Lapa patent describes a system that generates coupons for redemption. The coupons are generated for a specific customer and mailed to the customer. The coupons include the identification of the specific customer. The customer

is induced to shop at a particular retailer (column 5, lines 19-28). When a coupon is redeemed, information is used to determine coupons that are to be next generated for that particular customer.

The Day patent discloses a "paperless coupon system" for providing customized special offers to consumers (column 2, lines 37-40). Each customer receives a card associating it with a particular customer account and a store in a chain of stores (column 4, lines 25-41). Each store has one or more kiosks. The customer inserts the identification card into the kiosk. The kiosk outputs a shopping list of special offers for that customer. The same shopping list can include a lottery number. When checking out items at the time of purchase by the consumer, comparisons are made between the items being purchased and the special offer items. The checking out includes inputting identification card information.

As discussed in the previous Amendment and Response having a mailing date of March 17, 1999, the Oyama patent describes a system having three main programs. These include a questionnaire producing program, a reply gathering program and an analyzing program. The system enables individual personal data to be gathered and subsequently analyzed. As part of gathering information, messages are printed. A message may comprise information about a service ticket having added value to be given to the replier of the questionnaire in reward for the reply (column 10, lines 33-36).

With reference to amended Claim 1, key patentable distinctions are set out in this method claim. Claim 1 calls for, among other things, performing a determined one of (a) and (b). This performing step is conducted under control of the interactive apparatus in response to the identification card being input thereto by the first consumer. Sub-step (a), when conducted as determined by the interactive apparatus, involves the generation of a



coupon having specific product information, expiration information and discount information. Additionally, a benefit receipt different from and separate from the coupon is generated. When sub-step (b) is generated, the benefit receipt and not the coupon is generated. This claim language emphasizes the flexibility and activity involving the interactive apparatus. Support for such claim language can be found in connection with the description of Fig. 4, particularly on page 26, as well as descriptions related to the operation of the interactive apparatus on pages 37-39. Particularly with regard to the determined sub-steps (a) and (b), page 38 discusses providing one or more benefit receipts including coupons and, additionally or alternatively, offering incentives to interactive survey questions. Hence, Applicant's method involves a number of functions that enhance flexibility of gathering information and providing consumer benefit receipts to the consumer. In contrast, the De Lapa patent has no comparable interactive apparatus. The Examiner recognizes this major deficiency in the De Lapa patent and argues that the teachings of the Day patent can be combined with the system and method of the De Lapa patent. First, such a purported combination lacks Applicant's claimed invention. Specifically, the Day patent merely discloses a kiosk that outputs, upon receipt of a consumer identification card or other identification information, a single list of special offers and which can also include a lottery number. No option or determination is made by the kiosk. That is, Applicant's interactive apparatus can provide a coupon and a benefit receipt different from the coupon. Alternatively, Applicant's methodology involves the interactive apparatus providing the benefit receipt and not the coupon. No such flexibility and determination is found in Day. Relatedly, when sub-step (a) is conducted by the interactive apparatus, a benefit receipt separate from the coupon is provided. The Day patent teaches a single list that includes

special offers and a lottery number can also be printed on the list. Dissimilarly, Applicant's claim involves separately providing a coupon and a consumer benefit receipt different from the coupon, when sub-step (a) is provided under control of the interactive apparatus.

Furthermore, Claim 1 recites that when sub-step (b) is performed, the benefit receipt is generated by the interactive apparatus after it receives a response to at least a first interactive survey question. Neither the Day nor the De Lapa patent suggests this key feature, as recognized by the Examiner. This important operation is highly useful in obtaining information, with reliance on incentives, such as the benefit receipt different from the coupon.

In addition, amended Claim 1 defines the first interactive survey question to be unassociated with or not directed to any specific product that could be purchased by the first consumer. Such a survey question unassociated with any specific product can, in one or more embodiments, include marketing or other data, such as opinions or reactions from consumers to one or more topics (page 29, lines 24-28 and page 30, lines 1-2). This claim language, therefore, emphasizes the diversity of gathering information when using the present invention. In contradistinction, not only do the De Lapa and Day patents fail to suggest such a survey question or questions and providing a benefit receipt based thereon, they are likewise deficient in any suggestion of the identification or type of an interactive survey question as now defined in Claim 1.

The discussion of the prior art continues with the following points directed to the non-obviousness of Applicant's invention and the impropriety of the proposed combination. The Examiner urges that it would be obvious to combine the teachings of the secondary reference of Day with the De Lapa primary reference. Applicant respectfully disagrees. At

the foundation of the De Lapa system is the generation of coupons that are mailed to the user or consumer. This is in substantial contrast to the “paperless coupon system” touted by the Day patent. Given the system and operation of the De Lapa patent, it would have no use for and would not consider utilizing the Day kiosk. That is to say, the system and method of operation that employs mailed coupons that are redeemed at checkout has no use for, and no relevance to, the Day system and method of operation directed to a “paperless” operation, where coupons are not redeemed at checkout.

The Examiner further urges that it would be obvious to incorporate steps related to providing interactive survey questions in which incentives are offered. The Examiner’s position is so general that it would preclude patentability for any novel feature related to gathering information from consumers, particularly one that utilizes a number of consumer benefit receipts. More particularly, the Examiner essentially asserts that motivation to combine is present since it is desired to obtain consumer or marketing information in order to target consumers. Such an objective is sought by all inventions in this field and if the Examiner’s argument were to be accepted, no patentable merit could be found in any invention in which information is gathered for the purpose of targeting consumers.

If the rejection of Claim 1, as now amended, should be maintained, it is respectfully requested that it be pointed out with specificity how each and every step of Claim 1 is rendered obvious by the prior art of record, particularly where key steps are defined related to the flexibility and functionality of the interactive apparatus. Unless a *prima facie* case can be made to that effect, Claim 1 should now be allowed.

Claims 2-7 and 9-10 recite further details of the steps of Claim 1. Particularly when taken together with the patentable features of Claim 1, these dependent claims should also be allowed.

Claim 11 is an independent apparatus claim that is similar in scope to Claim 1. Claim 11 calls for a system that includes, among other things, an interactive apparatus that is responsive to identification information of a first consumer for presenting interactive survey questions. The interactive apparatus performs one of (a) and (b) in response to the identification information from the first consumer. The interactive apparatus can generate a coupon having specific product information, expiration information and discount information and a benefit receipt different from the coupon. The interactive apparatus can generate the benefit receipt and not generate the coupon. Furthermore, when (b) is performed the benefit receipt is generated after receipt by the interactive apparatus of a response to at least a first interactive survey question. The first interactive survey question is unassociated with any specific product. Thus, for the same reasons presented in the discussion of Claim 1, Claim 11 should be held allowable.

Additionally, Claim 11 requires that the interactive apparatus monitor whether the first interactive survey question was previously responded to by the first consumer. This aspect of the invention is related to avoiding the taking into account of information from the same consumer when it is advantageous, depending on the interactive survey questions (page 31, lines 20-28 and page 32, lines 1-9). As previously noted, the De Lapa patent has no comparable interactive apparatus. The Day patent not only fails to utilize or even suggest such an interactive survey question, it also lacks any monitoring, or need to do so, regarding whether a first interactive survey question was previously responded to by the same

consumer. The Oyama patent merely describes a single approach involving a questionnaire presented to one or more individuals for gathering information, unlike Applicant's system, which relies on at least two different ways of obtaining consumer information. Furthermore, Claim 11 requires an interactive apparatus to provide one of (a) and (b). No such flexibility or determination is made in the Oyama system. Relatedly, when (a) is provided, the Oyama patent lacks any disclosure of two different items being provided to the first consumer.

Based on these numerous patentable distinctions, it is submitted that a finding of obviousness can no longer be maintained. Claim 11 should, therefore, be found allowable.

Referring next to independent method Claim 20, it is similar in scope to amended Claim 1. Among other steps, it requires performing a determined one of (a) and (b) under control of the interactive apparatus, after receiving identification information from the first consumer. The sub-steps (a) and (b) are defined as recited in Claim 1.

Based on the substantial reasoning establishing non-obviousness and the inadequate support attempting to combine the De Lapa and Day patents, the rejection of Claim 20 should be re-considered and found allowable.

Claim 22 is the only other independent claim. Claim 22, as amended, defines an interactive apparatus in a system for providing different consumer benefit receipts. The interactive apparatus includes a managing apparatus that provides one of (a) and (b). The managing apparatus can include one or both of the controller and processor of Fig. 4. When (a) is provided by the managing apparatus, both a coupon having specific product information, expiration information and discount information and a benefit receipt different from the coupon are provided. When (b) is provided using the managing apparatus, the benefit receipt is generated and no coupon is generated. As previously pointed out in the

discussions relevant to the De Lapa and Day patents, no comparable managing apparatus that can provide (a) and (b) to different consumers is taught or suggested by such patents. Indeed, the De Lapa patent does not even suggest such a managing apparatus of an interactive apparatus, while the Day patent is dedicated solely to outputting a list of special offers and a lottery number that can be included on the list, upon receipt of identification information. No comparable flexibility or option capability is present. Moreover, the interactive apparatus has an input device that receives responses to survey questions. When (b) is provided by the managing apparatus, the benefit receipt is generated by the printer after a response by the first consumer is provided to the input device to at least the first survey question. As previously established, such an input device having this claimed function is not found in the Day patent. Additionally, for the same reasons presented in detail in connection with the discussion of Claim 1, the obvious finding made by the Examiner lacks adequate support and, certainly, no *prima facie* case is presented to establish the alleged obviousness of the combination of elements recited in the claim.

In view of this combination of patentable features, as recited in the context of the interactive apparatus of the present invention, it is submitted that Claim 22 should be allowed.

Claims 24-28 are dependent claims that depend, directly or indirectly, from Claim 22. Claim 24 requires that the managing apparatus monitor whether the first consumer previously responded to the first survey question. As noted in the discussion of Claim 11, none of the prior art of record teaches or suggests this aspect of the present invention. Claim 25 requires that the first survey question be unassociated with any specific product that can be purchased by the first consumer. As previously pointed out in the discussions of other

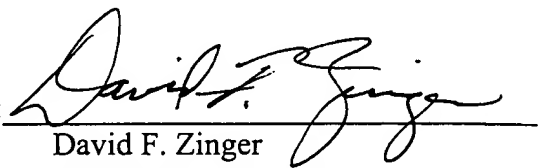
independent claims, the prior art of record lacks any suggestion of this claim language related to this limitation associated with the first survey question. Claim 26 specifically defines the first survey question to include one of opinion information and general product information. This is in contrast to the dedicated or specific product direction taken by each of the De Lapa and Day inventions and particularly the lack of any survey question related to the information of Claim 26. Claim 27 recites a further function of the managing apparatus in connection with generating another coupon based on the response to the first survey question. A combination of the response to the first survey question, as defined in Claim 22, and a coupon generated as a function thereof, is not found in the prior art of record. Claim 28 particularly defines the managing apparatus to include the controller and the processor of Fig. 4. Based on these patentable limitations, Claims 24-28 should also be allowed.

A check in the amount of \$27.00 is enclosed to cover the fee for the additional claims. Please charge deposit account no. 19-1970 for any additional amount that might be due in connection with the filing of this Amendment and Response.

A sincere effort has been made to place this application in condition for allowance. Early notice of such allowance is, therefore, earnestly solicited.

Respectfully submitted,

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